REMARKS

Applicant has cancelled claims 14-33, inclusive. New claims 34-53, inclusive, have been substituted to better encompass the full scope and breadth of the invention notwithstanding Applicant's belief that the claims would have been allowable as previously filed. Accordingly, Applicant asserts that no claims have been narrowed within the meaning of *Festo*.

I. Rejection of Claims 14-17, 23, 25, 27-32 Under 35 U.S.C. §103(a) as being anticipated by Ong in view of Broadhurst

Claims 14-17, 23, 25, 27-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ong (U.S. Publication No. 2002/0156800) in view of Broadhurst (U.S. Patent No. 6,560,634). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Examiner states that Broadhurst teaches "performs a multitude of searches simultaneously and transparently to the user eliminating individual searches" (col 2, lines 33-40) therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of generating content from a URI as taught by Ong while displaying available domain names for registration as taught by Broadhurst in order to "eliminate the need of individual searching of available domain names."

Examiner attempt to show motivation of Ong and Broadhurst to combine is not clear and too ambiguous. Applicant assumption is that Examiner is attempting to show that Broadhurst "multitude of searches simultaneously to eliminate individual searches" somehow also suggests simultaneously locating a file from a network while in addition also separately searching for available domain names.

If this is the case, this would no doubt be a misinterpretation because Examiner does not consider context of Broadhurst (col. 2, lines 33-40) as a whole. For instance, upon closer examination of (col. 2, lines 33-40) one can see that "multitude of searches simultaneously to eliminate individual searches" is ***strictly in the context of overcoming the shortcomings of existing domain name searching techniques and does not pertain in any way to the field of resource location***. Words left out by Examiner are underlined in the following Broadhurst quote (col 2, lines 33-40), "overcomes the shortcomings of existing domain name searching techniques by performing a multitude of searches simultaneously and transparently to the user. Specifically, the improved query server searches for existing domain name records in various domains and then displays the results in a formatted manner, thus eliminating the need for a user to perform individual searches."

The context of "existing domain name searching techniques" contemplated by Broadhurst can be found in the previous paragraph (col. 2, lines 10-12 and lines 23-28) which teach the burden of a user initiating a request specifically to check domain name availability. No where does Broadhurst teach or suggest performing domain name availability searching in response to the user initiation of request types of other separate network services such as the performance of a resource location request. Furthermore, fundamental operative terms such as "resource location", "network resource", and "resolution", and "resolver" **can not** be found anywhere in Broadhurst from a USPTO full-text search which serves as further contention that Broadhurst does not make any mention of the field of locating resources in any way. Applicant fails to see how "eliminate the need of individual searching of available domain names" is a teaching or suggestion by Broadhurst as a motivation to combine with teaching of Ong or even in a broader sense to be combined with the field of resource location services, in general.

Broadhurst teaching is limited to the field of domain name availability searching which is not suggested or taught by Ong in any way. Another limitation of Broadhurst is it remains the burden of a user to initiate a domain name availability search request. ***No where does Broadhurst teach or suggest performing domain name availability searching in response to the initiation of other request types.***

The field of resource location services and the field of domain name registration services are separate network services used for different purposes to obtain different results with no suggestion from either Ong nor Broadhurst to combine these separate fields in any way.

Ong And Broadhurst Use Similar Methods To Solve Different Problems

Ong and Broadhurst both improve their separate fields of resource location and domain name availability searching in a similar manner. For instance, as pointed out by Examiner Interview Friday, August 18, 2004, Ong uses relative archive time stamps (page 2, para 32-34) as a way to use a persistent URL to access different versions of the same document archived over a series of dates within a relative time frame. By so doing, Ong teaches how improvements can be made to more readily locate and access multiple resources eliminating the need for a user to perform individual requests for each document. As earlier shown, this is a similar method to the kind of improvements that Broadhurst makes in the domain name availability searching the elimination of user performing individual requests. ***Though both Ong and Broadhurst each improve their respective fields and arts***

in a similar manner, no where does either teach or suggest explicit or otherwise a motivation to combine their teaching for a new result.

During Examiner Interview the subject of resource location was tied into domain name resolution and hence suggested that this somehow further tie into domain name availability giving a motivation to combine though not suggested anywhere in Ong or Broadhurst. Applicant teaching is not necessarily dependent upon domain name resolution because ***the URL can include an IP address and Applicant can in this regard still perform present invention without relying on having to perform a DNS resolution request.***

Ong and Broadhurst use DNS records for completely different purposes and do not suggest using such records for any other purpose outside of their respective arts. Ong uses DNS to resolve a domain name into an IP address and redirect a first domain name to a second domain name under certain conditions whereas Broadhurst uses DNS ***only after the burden of a user initiating a domain name registration or availability type request*** to determine for existence of the domain name only in order to more quickly eliminate what domain names might still be available for registration. It is important to remember that Broadhurst teaches of method for determining what is unavailable in order to narrow which domain names might potentially still be available (col. 6 lines 23-26).

Applicant present invention does not teach improvements to the registration process itself, but rather the present invention ***teaches how the domain name registration process can only first be started in response to initiation of requests other than that of a registration request in this case more specifically from the initiation of a resource location request***. Currently, domain names can only be registered or determined available upon user initiation of a domain name registration or availability request. Though Broadhurst improvements add value and streamline the registration process itself, there is no teaching or suggestion that the registration process is initiated as a result of a resource location request.

There is an important distinction to be drawn between domain name resolvability and domain name availability. ***A domain name determined not resolvable might indicate that there is a high probability that the domain name may be available***, however, ***the distinct step of determining whether a domain name is available for registration*** (e.g., processing a registration request) in response to determining that the domain name is determined unresolvable ***must be performed to assure that the unresolvable domain name is indeed truly available for registration***. For instance, zone files are used to determine resolvability but only update and propagate through the DNS once a day. Due to this type of zone file updating, ***there is a period of time where a domain name that is not***

resolvable is also not available for registration. Therefore a separate request to check for domain name availability must be separately performed.

Claims are not a question of Obviousness but rather a question of Double-Patenting

Both U.S. Patent 6,338,082 (Serial 09/525,350 which is incorporated by reference of present invention) and continuation U.S. Patent 6,678,717 by Applicant teaches how domain name registration requests can be performed in response to the initiation of other request types such as a failed resource location request, for example. Both of these patents have already been submitted in an IDS form to Examiner on May 21, 2004. Independent Claim 34 of current application is distinguished over Applicant's prior applications because in the present application Applicant does not rely upon failure of a resource location request in order to determine domain name availability. **The question of double-patenting is something however that Examiner must ultimately address.**

Applicant already discloses shortcomings of Broadhurst in 6,338,082 (col 5, lines 25-36) by stating that Broadhurst does not consider integrating registration services with or types of network services. Furthermore, Applicant specifically teaches shortcomings of prior art in 6,338,082 (col 7, lines 4-25) which teaches the distinction between domain name resolvability and availability by showing how domain name resolution is used in the context of resource location services and domain name availability is used in the context of domain name registration services.

To date these services have remained separate and have never been integrated into a unified service. By so doing, the location field of a client web browser, for example, may now be used to provide a means for determining the availability of domain names directly from the browser in addition to being used as a tool for locating network resources.

No Teaching or Suggestion to Combine References to Produce Applicant Claimed Invention

Applicant submits that there is no teaching or suggestion to combine the features of Ong and Broadhurst to produce Applicant claimed invention. In considering whether providing the claimed features would have been obvious to one of ordinary skill in the art at the time of applicant invention, the claimed invention must be considered as a whole. The question is whether there is something in the prior art as a whole to suggest desirability, and thus the obviousness of one of ordinary skill in the art, of making applicant claimed invention. Lindemann Maschinenfrabric GmbH vs. American Hoist and Derrick 730 F.2d 1452, 1462 (Fed. Cir. 1984).

According to MPEP, the motivation to combine or extend prior art references under USC 103(a) cannot be based upon mere common knowledge and common sense as to the benefits that would result in such combination or modification. Instead such motivation must be based upon a specific teaching in the prior art, such as a specific suggestion in a prior art reference. In light of the above, it is Applicant's belief that ***Examiner does not establish a prima facie case of obviousness*** under 35 U.S.C. §103.

II. Rejection of Claim 18-22, 27, 31-32 Under 35 U.S.C. §102(e) as being anticipated by Ong in view of Broadhurst in further view of Wodarz

Claims 18-22, 27, 31-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ong (U.S. Publication No. 2002/0156800) in view of Broadhurst (U.S. Patent No. 6,560,634) and in further view of Wodarz (U.S. Patent No. 5,999,912). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Wodarz and the art of online advertisement selection, in general, teaches how advertisement content selection is context sensitive to the content of a requested web page. For instance, Examiner makes specific reference in Wodarz (col 2, lines 3-5, lines 15-21, col. 3 table 1, lines 1-8, lines 22-31, and col. 3 lines 55 - col. 4 line 5), with all passages relating to the teaching of "ad tags." However, Wodarz teaches the use of ad tags by having ad tags embedded in the content of a web page so that when the web page is retrieved, an advertisement can be selected based on the ad tags received from the retrieved web page content. Though one of the parameters of the ad tag specifies a URL, the context of the URL pertains to a destination URL in response to clicking the retrieved advertisement that is rendered as part of the web page based on ad tag parameters.

Unlike Wodarz and prior art, Applicant claimed invention is distinct for the fact that Applicant teaches that ad selection can be made independent of such web page content. For instance, when a URL is received as part of a resource location request, an advertisement can be selected by using keywords extracted from the URL before any web page content corresponding to the URL is accessed. Some advantages to this is quicker load time, an ability to control ad content regardless of what web page may be displayed. This is an important limitation that has remained overlooked and not taught in the art. Because advertisement selection does not depend upon accessing web page content, the advertisement can be selected before web page content is even retrieved. The step of generating an advertisement selection from one or more URL components is a narrowed limitation and serves the purpose of simplifying ad selection process. Small improvements and simplifications

are significant particularly when taking into consideration that the field of ad content selection is a crowded art.

III. Notice of References Cited, PTO-892

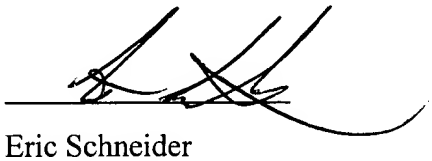
Applicant has carefully reviewed the references cited but not applied. Applicant respectfully submits that none of those references, alone or in any combination, remedy the deficiencies of the applied art, nor teach or suggest the claimed invention alone or in any combination.

IV. Conclusion

For all of the above reasons, the present application and pending claims 34-53, as amended, are believed to be in condition for allowance. Applicant respectfully requests the Examiner to issue a formal Notice of Allowance directed to claims 34-53, inclusive.

Should the Examiner believe that telephone correspondence would be helpful to expedite favorable prosecution, the Examiner is invited to contact the Applicant at the telephone number listed below.

Respectfully submitted,



September 22, 2004

Eric Schneider

pro se Applicant

13938A Cedar Road #258

University Heights, Ohio 44118

(216) 231-2400 - telephone